

REMARKS

The non-final Office Action mailed November 25, 2003 has been received and carefully reviewed. Claims 1-47 are pending in the application. Claims 1-47 were rejected.

In paragraph 1 on page 2 of the Office Action, claims 1-10 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Applicants respectfully traverse the rejection, but in the interest of expediting prosecution have amended claim 1 to overcome the rejection. Applicants respectfully submit that the amendments to claim 1 define the statutory subject matter of the invention, but do not narrow the scope of the claim.

In paragraph 1 on page 3 of the Office Action, Claims 1-6, 8-10 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5872895 to Zandee et al.

In paragraph 11 on page 5 of the Office Action, claims 11-13, 15-17 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5872895 to Zandee et al.

In paragraph 18 on page 6 of the Office Action, claims 18-20, 22-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5872895 to Zandee et al.

In paragraph 25 on page 8 of the Office Action, claims 34-36, 38-40 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5872895 to Zandee et al.

In paragraph 31 on page 12 of the Office Action, claims 25-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5704021 to Smith et al.

In paragraph 38 on page 10 of the Office Action, claims 41-43, 45-47 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5872895 to Zandee et al.

In paragraph 48 on page 14 of the Office Action, claims 7, 14, 21, 37, 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5872895 to Zandee et al., as applied to claim 12 above, and view by U.S. Patent No. 5704021 to Smith et al.

Applicants respectfully traverse the §§ 102(e) and 103(a) rejections. Applicants respectfully submit that the cited references do not teach, disclose or suggest Applicants' claimed invention.

To establish a prima facie case for rejection under 35 U.S.C. § 102, all the claim limitations must be taught, disclosed or suggested by the cited reference. To establish a prima

facie case for rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the cited prior art references, see M.P.E.P § 2143.01.

In the instance case, the requirements are not present and a prima facie rejection fails under 35 U.S.C. §§ 102(e) and 103(a) because the Office Action fails to cite a reference or references that teach, disclose or suggest all the claim limitations of Applicants' application.

For example, claim 1 requires using tagged secondary resources and a data structure embodied in a tangible medium that provides object level management of a document datastream in a print system using such secondary resources. A printer file defines how application program output is mapped to each page and then printed. Rendering is the process a printer uses to translate the commands of a printer file to create an image. Rendering control is provided without modifying the heterogeneous object. Moreover, claim 1 recites using at least one mapping structure for identifying rendering control data as a secondary resource and at least one include object structure for referencing the rendering control data. A secondary resource is a resource associated with an object that may itself be processed as a resource.

Zandee et al. fail to suggest using at least one mapping structure for identifying rendering control data as a secondary resource and at least one include object structure for referencing the rendering control data. In fact, Zandee et al. do not map rendering control data from a secondary resource to an object to be printed. Rather, Zandee et al. merely provide a method for performing color matching between devices that use different rendering methods, e.g., additive color rendering, subtractive color rendering, and which have different color capabilities. According to Zandee et al., as each page of a document is drawn into the printing graphics port, the printer driver translates the commands into the equivalent instructions for the printer, essentially translating the pixel maps into dot-placement instructions. The printer driver can examine entire pages to determine whether a page needs special processing prior to printing. When a page is to be printed, a user selects between business/graphics, photographic or automatic rendering. A profile that includes a header, a tag table and tagged element data according to the type of rendering selected by the user is obtained. The rendering is performed by using a tag table includes a pointer to a specific element in tagged element data for specifying how that object is to be rendered.

However, Zandee et al. fail to teach, describe or suggest the identification of rendering control data as a secondary resource. Moreover, Zandee et al. fail to teach, describe or suggest referencing the rendering control data using an include object structure. Zandee at best merely suggests determining if a profile is associated with an object and performing a color matching session on the object using the associated profile. Still, Zandee et al. do not suggest the element recited in claim 1.

Smith fails to remedy the deficiencies of Zandee et al. Smith merely describes a method for identifying multiple color objects in a page. However, Smith et al. also fails to teach, describe or suggest the identification of rendering control data as a secondary resource. Further, Smith et al. fail to teach, describe or suggest referencing the rendering control data using an include object structure.

Thus, claim 1 is patentable over the cited references. Independent claims 11, 18, 25, 34 and 41 include similar limitations and are therefore patentable over the cited references for the same reasons. Nevertheless, independent claims 11, 18, 25, 34 and 41 recite additional novel elements and limitations.

Dependent claims 2-10, 12-17, 19-24, 26-33, 35-40 and 42-47 are also patentable over the references, because they incorporate all of the limitations of the corresponding independent claims 1, 11, 18, 25, 34 and 41. Further dependent claims 2-10, 12-17, 19-24, 26-33, 35-40 and 42-47 recite additional novel elements and limitations. Applicants reserve the right to argue independently the patentability of these additional novel aspects. Therefore, Applicants respectfully submit that dependent claims 2-10, 12-17, 19-24, 26-33, 35-40 and 42-47 are patentable over the cited references.

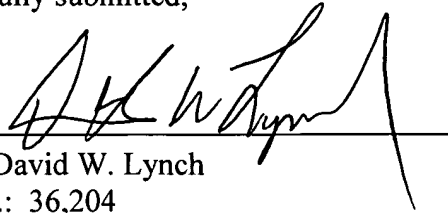
Appl. No. 09/507,022
BLD990044US1/IBMN.005US01
Amdt. Dated March 25, 2004
Reply to Office Action of November 25, 2003

On the basis of the above amendments and remarks, it is respectfully submitted that the claims are in immediate condition for allowance. Accordingly, reconsideration of this application and its allowance are requested.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact attorney for Applicants, David W. Lynch, at 651-686-6633 Ext. 116.

CRAWFORD MAUNU PLLC
1270 Northland Drive, Suite 390
Saint Paul, MN 55120
(651) 686-6633

Respectfully submitted,

By: 
Name: David W. Lynch
Reg. No.: 36,204